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EXAMINER

LE, HUYEN D

ART UNIT

PAPER NUMBER

3751

DATE MAILED: 12/16/2003

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/691,944

Applicant(s)

JEAN-LOUIS GUERET

Examiner

Huyen Le

Art Unit

3751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09/29/03.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-175 is/are pending in the application.

4a) Of the above claim(s) 4-6, 14-28, 36, 37, 44, 46, 47, 50, 51, 57, 58, 82, 83, 87, 100-102, 109-115, 131-133, 140-146 and 162 is/are withdrawn from consideration.

- 5) ☒ Claim(s) 13 and 80 is/are allowed.

- 6) ☒ Claim(s) See Continuation Sheet is/are rejected.

- 7) ☒ Claim(s) 73, 92 and 167 is/are objected to.

- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some * c) ☐ None of:

- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____.
- ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- ☐ Interview Summary (PTO-413) Paper No(s). _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

Continuation of Disposition of Claims: Claims rejected are 1-3,7-12,29-35,38-43,45,48,49,52-72, 74-81,84-86,88-91, 93-99,103-108,116-130,134-139,147-161 and 163-166, 168-175.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3, 7-12, 29-35, 41-43, 48, 49, 52, 53, 56, 59-63, 98, 99, 103-108, 177 118, 120-124, 126, 127, 129, 130, 134-139, 148, 149, 151-155, 157-159 and 173-175 are rejected under 35 U.S.C. 102(b) as being anticipated by Capezzuto (3,132,370).

The Capezzuto reference discloses an applicator comprising a reservoir 10, a removable closure 20, an applicator member 36 having a product application surface movable between a first position wherein it extends out of the reservoir (Fig. 3) and a second position wherein it is substantially contained in the reservoir (Fig. 2), and an elastically compressible support 34 supporting the applicator member 36 and the support 34 having a compressibility greater than the compressibility of the applicator member 36.

Regarding claims 7-10 and 134-136, the support 34 includes a block of foam (col. 2, lines 59-60).

Regarding claims 11, 12 and 139, the applicator member 36 is attached to the support 34 by crimping by flange 28.

Regarding claims 29 and 30, the product application surface of the applicator member 36 has a convex profile or a dome (Fig. 3).

Regarding claim 32, the applicator member 36 includes a perforated element (col. 2, lines 65-66).

Regarding claims 41-43 and 151-153, the reservoir includes a compressible body which is a deformable tube (col. 2, line 16).

Regarding claims 59-62, 126, 127, 157 and 158, all functional statements of the intended use have been carefully considered but deemed not to impose any structural limitations on the claims distinguishable over the applicator device of Capezzuto which is capable of being used to apply any kind of cosmetic products, glue, correction fluid, and a stain remover.

Regarding claims 63 and 159, the method of applying a cosmetic product is inherently performed during normal operation of the applicator.

Regarding claim 64, the applicator device comprises an absorbent member having a first portion 36 configured to apply a liquid product to a surface and a second support portion 34 configured to elastically support the first portion 36, wherein the first portion 36 has a different density than the second portion (because of material differences).

Regarding claim 81, the applicator member 36 includes a recessed portion which is an area located under the lower surface of the applicator member as shown in Figs. 2 and 3.

Regarding claim 85, the second end portion of the applicator 36 is in a first position, the application member 36 is in flow communication with the reservoir.

3. Claims 1-3, 7-12, 29-35, 41-43, 48, 49, 52, 53, 56, 59-63, 98, 99, 103-108, 117, 118, 120-124, 126-130, 134-139, 148, 149, 151-155, 157-159, 173-175 are rejected under 35 U.S.C. 102(b) as being anticipated by Schwartzman (3,266,079).

The Schwartzman reference discloses an applicator comprising a reservoir 10, a removable closure 76, an applicator member 21 having a product application surface movable between a first position wherein it extends out of the reservoir (Fig. 3) and a second position wherein it is substantially contained in the reservoir (Fig. 3), and an elastically compressible

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support 20 supporting the applicator member 21 and the support 20 having a compressibility greater than the compressibility of the applicator member 21.

Regarding claims 7-10 and 134-136, the support 34 includes a block of foam.

Regarding claims 11, 12 and 139, the applicator member 36 is attached to the support 34 by bonding.

Regarding claims 29 and 30, the product application surface of the applicator member 36 has a convex profile or a dome (Fig. 2).

Regarding claim 32, the applicator member 36 includes a felt.

Regarding claims 41-43 and 151-153, the reservoir includes a compressible body which is a deformable tube.

Regarding claims 63 and 159, the method of applying a cosmetic product is inherently performed during normal operation of the applicator.

4. Claims 64-72, 74-79, 81, 84-91, 93-97, 160, 161, 163-166 and 168-172 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 0872193.

The EP 0872193 reference discloses an applicator (Figure 5) comprising a reservoir 2, an absorbent member 10 including at least two portions, a first application portion 12 configured to apply the liquid product to a surface, and a second support portion 12' configured to elastically support the first portion 12, the first portion 12 includes a foam and has a density different than the second portion 12', wherein the absorbent member 10 comprises a face that faces toward the reservoir 2, the face being positioned with respect to the reservoir 2 so as to be loaded with product from the reservoir 2.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 38-40, 119 and 150 are rejected under 35 U.S.C. 103(a) as being unpatentable over Capezzuto (3,132,370).

The Capezzuto reference discloses an applicator device as described above.

Although the Capezzuto reference is not specific as to what sizes the open cells of the foam support 34 should be, it would have been obvious to one of ordinary skill in the art at the time the invention was made to select a size for open cells of the foam support within a certain range to best fit a particular applicator depending on a liquid applied and to optimize the performance of the applicator. See *In re Aller*, 105 USPQ 233, using the optimum or workable ranges involves only routine skill in the art.

7. Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Capezzuto (3,132,370) in view of McCabe et al (2,659,919).

The Capezzuto reference discloses an applicator device as described above.

Although the Capezzuto applicator device does not include a diaphragm portion on the reservoir 10, attention is directed to the McCabe et al reference which discloses another applicator device comprising a reservoir 12 having a diaphragm portion 14a for facilitating delivering the liquid 12 to an applicator member 17.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a reservoir with a diaphragm in the Capezzuto applicator device in view of the teaching of the McCabe et al reference in order to facilitating delivering the fluid to the applicator member.

8. Claim 54 is rejected under 35 U.S.C. 103(a) as being unpatentable over Capezzuto (3,132,370).

The Capezzuto reference discloses an applicator device comprising a closure member 20 including an element 38 of liner configured to engage the application surface.

Although the Capezzuto reference does not specifically disclose that element is made of a foam material, it would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute a foam element with a liner element inside the Capezzuto cap, wherein, wherein so doing would amount a mere substitution of one functional equivalent a cushion means for another within the same art that would work equally well in the Capezzuto reference device.

9. Claims 55, 125 and 156 are rejected under 35 U.S.C. 103(a) as being unpatentable over Capezzuto (3,132,370).

The Capezzuto reference discloses an applicator device as described above.

Although the Capezzuto reference is not specific that the compressibility of the support 34 is two to four times greater than the compressibility of the applicator member 36, it would have been obvious to one of ordinary skill in the art at the time the invention was made to select a support having a certain compressibility range to best fit a particular applicator design and to optimize the performance of the applicator. See *In re Aller*, 105 USPQ 233, using the optimum or workable ranges involves only routine skill in the art.

10. Claims 38-40, 119 and 150 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schwartzman (3,266,079)

The Schwartzman reference discloses an applicator device as described above.

Although the Schwartzman reference is not specific as to what sizes the open cells of the foam support 34 should be, it would have been obvious to one of ordinary skill in the art at the time the invention was made to select a size for open cells of the foam support within a certain range to best fit a particular applicator depending on a liquid applied and to optimize the

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performance of the applicator. See *In re Aller*, 105 USPQ 233, using the optimum or workable ranges involves only routine skill in the art.

11. Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schwartzman (3,266,079) in view of McCabe et al (2,659,919).

The Schwartzman reference discloses an applicator device as described above.

Although the Schwartzman applicator device does not include a diaphragm portion on the reservoir 10, attention is directed to the McCabe et al reference which discloses another applicator device comprising a reservoir 12 having a diaphragm portion 14a for facilitating delivering the liquid 12 to an applicator member 17.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a reservoir with a diaphragm in the Schwartzman applicator device in view of the teaching of the McCabe et al reference in order to facilitating delivering the fluid to the applicator member.

12. Claims 55, 125 and 156 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schwartzman (3,266,079).

The Schwartzman reference discloses an applicator device as described above.

Although the Schwartzman reference is not specific that the compressibility of the support 34 is two to four times greater than the compressibility of the applicator member 36, it would have been obvious to one of ordinary skill in the art at the time the invention was made to select a support having a certain compressibility range to best fit a particular applicator design and to optimize the performance of the applicator. See *In re Aller*, 105 USPQ 233, using the optimum or workable ranges involves only routine skill in the art.

Allowable Subject Matter

13. Claims 13 and 80 are allowed.

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14. Claims 73, 92 and 167 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

15. Applicant's arguments filed on September 29, 2003 in the Amendment (Paper No.16) have been fully considered but they are not persuasive.

In regard to applicant's arguments that the membrane 36 of Capezzuto being made of a woven or perforated plastic is not an "absorbent" material, the Capezzuto discloses the a resilient abrasion-resistant liquid-permeable membrane 36 which may be formed of fabrics of artificial or natural fibers (col. 1, lines 53-57 and col. 2, lines 64-66). For example, the Everett et al reference (5,562,650) shows natural fibers and artificial fibers which are wood and cotton and polyester and polypropylene (see col. 7, lines 50-53). Drelich (4,084,033) shows that exemplary of natural fibers are cotton and wool (see col. 2, lines 6-7). To an extent, fabrics of natural fibers for example, cotton or polyester, inherently have an absorbency property and are capable of absorbing liquid (see col. 3, lines 23-24 of Benitez (5,022,517) and col. 5, lines 30-31 of Smith (5,368,581)). Therefore, the membrane of Capezzuto is considered as an "absorbent " material as claimed.

In regard to applicant's arguments that Schwartzman does not disclose an upper layer being at least partially compressed, Schwartzman discloses an upper layer being made of a nylon knitted brush fabric (col. 2, lines 30-32). Synthetic fabric is capable of absorbing a liquid (see col. 3, lines 23-24 of Benitez (5,022,517) and col. 5, lines 30-31 of Smith (5,368,581)) and is inherently capable of being compressed.

Conclusion

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huyen Le whose telephone number is 703-306-5504. The examiner can normally be reached on Monday-Friday from 9:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Huson can be reached on 703-308-2580. The fax phone number for the organization where this application or proceeding is assigned is 703-308-7766.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0861.

HL
December 3, 2003



GREGORY L. HUSON
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